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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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#26

In re Application of
Corey S. Goodman et al
Serial No.: 08/971,172
Filed: November 14, 1997
Attorney Docket No.: B98-006-2

PETITION DECISION

This letter is in response to the petition under 37 CFR 1.181 received by facsimile transmission on June 19, 2001, seeking immediate allowance of all claims. It appears that this is a copy of a petition filed at an earlier date, but not yet correlated with the file.

No petition fee is due for this petition.

BACKGROUND

A review of the file history shows that this application was assigned to Examiner Bakalyar in Art Unit 1645 after completion of the filing requirements. The following communications have since taken place:

Examiner Bakalyar mailed a first Office action to applicants on September 14, 1998, setting forth a restriction requirement defining four separate inventions. Further, if the invention of groups III or IV were elected, an election of species was also required. A one month shortened statutory period for reply was set. (Signed by SPE Paula Hutzell.)

Applicants replied on September 18, 1998, by electing Group II, claims 4-6 and 8, without traverse.

The examiner mailed a letter of non-responsiveness to applicants on December 8, 1998, indicating that the election of species, as required, had been omitted. This letter was in error. (Signed by examiner Bakalyar.)

Following a telephone interview with SPE Anthony Caputa the letter mailed December 8, 1998, was vacated as being mailed in error and the application reassigned to examiner Witherspoon. The examiner mailed a new Office action to applicants on March 5, 1999, setting a three month shortened statutory period for reply. Claims 4-6 and 8 were rejected under 35 U.S.C. 112, first

paragraph, as being non-enabled by the specification as it relates to a specific EST deposit. Claim 8 was rejected under 35 U.S.C. 112, second paragraph as indefinite. Claims 4-6 were objected to as depending from a non-elected claim. Claim 8 was rejected under 35 U.S.C. 102(b) as anticipated by Wilson et al. Claim 8 was rejected under 35 U.S.C. 102(a) as anticipated by Marra et al. (Signed by SPE Caputa.)

Applicants replied (Paper #11) on May 18, 1999, by canceling all pending claims and replacing them with claims 10-67. Applicants requested rejoinder of process claims 43-49 upon allowance of product claims 10-42 and 50-67. Applicants argued that the amendments overcame the rejections under 35 U.S.C. 112, first and second paragraphs, and the rejections over prior art. A supplemental amendment amending claim 10 and correcting a term in a number of other claims was filed July 29, 1999, and entered.

On October 14, 1999, examiner Witherspoon mailed a Final Office action to applicants. The examiner indicated that claims 43-49 were withdrawn as directed to an invention not originally presented and constructively non-elected by original presentation. The examiner rejected claims 10-42 and 50-67 under 35 U.S.C. 112, first paragraph, as lacking written description in the specification and as not having possession of the invention at the time of filing. A three month shortened statutory period for reply was set.(Signed by SPE Anthony Caputa.)

In reply (Paper # 14) applicants filed an amendment after final rejection having a Certificate of Mailing of November 12, 1999. Applicants proposed two minor amendments to the specification. Applicants argued that the rejection under 35 U.S.C. 112, first paragraph, was in error and provided references in the specification to show support for the invention claimed.

The application was transferred to examiner Turner. The finality of the previous Office action was withdrawn and the amendment entered. The examiner mailed a new non-final Office action to applicants on January 21, 2000, setting a three month shortened statutory period for reply. The examiner acknowledged the request for rejoinder of claims 43-49, but deferred consideration thereof until product claims are indicated as allowable. Claims 10-42 and 50-67 were rejected under 35 U.S.C. 112, second paragraph, as indefinite, pointing out specific terms which needed definition. Claims 10-11, 19-20, 28-29 and 35 were rejected under 35 U.S.C. 102(b) as anticipated by Wilson et al as evidenced by Sambrook et al. (Signed by SPE Christina Chan.)

Applicant replied (Paper #17) on February 7, 2000, by presenting arguments regarding the rejections under 35 U.S.C. 112, second paragraph, and providing affidavits under 37 CFR 1.131 and 1.132.

On May 10, 2000, examiner Turner mailed a new non-final Office action to applicants. The examiner maintained the rejection under 35 U.S.C. 112, second paragraph, for indefiniteness for the reasons of record. The affidavit under 37 CFR 1.132 was reviewed, but considered insufficient to overcome the rejection. Claims 10-11, 19-20, 28-29 and 35 were rejected under 35 U.S.C. 102(b) as anticipated by Wilson et al for reasons of record and noted that the affidavit was

insufficient to overcome the availability date of the reference under 35 U.S.C. 102(b). Claims 10-42 and 50-67 were newly rejected under 35 U.S.C. 112, first paragraph, as lacking written description in the specification. Claims 10-42 and 50-67 were newly rejected under 35 U.S.C. 112, second paragraph, as having a lack of antecedent basis in the independent claims for limitations in the dependent claims. Claim 51 was newly rejected under 35 U.S.C. 102(a) as anticipated by Genbank Accession Number AA499103. Claims 10-11, 22-23, 50-52 and 62-64 were newly rejected under 35 U.S.C. 102(a) as anticipated by Genbank Accession number Z95705. Claims 50 and 65-67 were newly rejected under 35 U.S.C. 102(b) as anticipated by Genbank Accession number H19148. Claim 56 was newly rejected under 35 U.S.C. 102(b) as anticipated by Genbank Accession number I24739. Claims 29, 31 and 38 were newly rejected under 35 U.S.C. 103(a) as unpatentable over Genbank Accession number Z95705 in view of Sambrook et al. A three month shortened statutory period for reply was set. (Signed by SPE Christina Chan.)

Applicants replied (Paper #21) on August 31, 2000, authorizing the fee for an extension of time (one month) be charged to a Deposit Account (which appears not yet to have been done) and extensively amending the specification, canceling claims 10-67 and replacing them with claims 68-119, and providing a new affidavit under 37 CFR 1.131. Applicants averred that the rejections under 35 U.S.C. 112, second paragraph, were overcome by the new set of claims. Applicants also argued the rejection under 35 U.S.C. 112, first paragraph, is in error in that the claims and specification are in compliance with the written description requirements. The rejections under 35 U.S.C. 102 were argued as overcome by amendments limiting the claims or by the affidavit. The rejections under 35 U.S.C. 103 were also stated to be overcome by the affidavit.

The examiner on December 12, 2000, then mailed a sequence requirement letter to applicants noting some apparent errors in the specification and omission of SEQ ID NOs in certain instances and requiring compliance with 37 CFR 1.821-1.825. The examiner also required a substitute specification in view of the numerous amendments to the original specification. A one month shortened statutory period for reply was set. (Signed by primary examiner Christine Saoud.)

Applicants replied on January 9, 2001, with a substitute specification and requested entry therein of a few additional minor amendments. Explanatory remarks accompanied the proposed amendments. A new sequence listing was not supplied as the original was contended to be correct.

On March 27, 2001, the examiner mailed a new non-final Office action to applicants. The examiner objected to the amendment to the specification of September 7, 2000, for insertion of new matter. Claims 68-119 were rejected under 35 U.S.C. 101 as not being supported by a specific and substantial credible asserted utility or well established utility. Claims 68-119 were rejected under 35 U.S.C. 112, first paragraph for lacking a credible asserted utility and claims 82, 92, 100, 102-104 and 113-114 were further rejected as containing subject matter not described in the specification. Claims 88-90 were rejected under 35 U.S.C. 102(a) as anticipated by Genbank Accession No U88183 and Sptrembl-11 sequence O01632, which rejection was not overcome by

the submitted affidavit under 37 CFR 1.131. Claims 108-110 were rejected under 35 U.S.C. 102(a) as anticipated by Genbank Accession No. Z95705 which rejection was not overcome by the affidavit under 37 CFR 1.131. Claims 94-95 were rejected under 35 U.S.C. 103(a) as unpatentable over Genbank Accession No. O01632 in view of Sambrook et al. A three month shortened statutory period for reply was set. (Signed by primary examiner Christine Saoud.)

The Office has not correlated a reply, if made, to this Office action.

DISCUSSION

35 U.S.C. § 131 provides that the USPTO shall cause an examination to be made of the application, and 35 U.S.C. § 2(b)(2) (formerly 35 U.S.C. § 6(a)) provides that the USPTO may establish regulations, not inconsistent with law, to govern the conduct of proceedings within the USPTO.

35 U.S.C. §§ 131 and 132 provide that an application shall be examined, and, if the applicant persists in his or her claim for a patent, reexamined. 35 U.S.C. § 132 does not preclude further examination of the application at the request of the applicant or initiative of the USPTO.

35 U.S.C. § 134 provides that an applicant, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

Petitioner argues that the provisions in 37 CFR 1.113 that permit reexamination of a rejected application do not permit unspecified subsequent reexaminations and are clearly proscribed by 35 U.S.C. §§ 131 and 132.

35 U.S.C. 151 provides that if it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant.

Applicants' claims have changed significantly during the course of prosecution of this application as seen below:

Originally elected claim 4 (as it depends from claim 1): Claim 4. A recombinant nucleic acid encoding a polypeptide according to claim 1.

Claim 1. An isolated Robo polypeptide comprising SEQ ID NO: 2, 4, 6, 8, 10 or 12, or a polypeptide domain thereof having at least 12 consecutive residues thereof and a Robo-specific activity, wherein said domain is encoded by neither EST yq76e12 nor yq76e12.

Claim 10. (Paper # 11) (Replaced claim 4/1.) A recombinant nucleic acid comprising a coding strand encoding a polypeptide comprising SEQ ID NO:2, 4, 6, 8, or 10, or a subsequence thereof having at least 12 consecutive residues thereof, wherein said subsequence is contained in neither SEQ ID NO:8, residues 168-217, nor SEQ ID NO:8, residues 1316-1520, nor SEQ ID NO:12, wherein said strand is flanked by fewer than 500 bp of flanking sequence.

Claim 10 (Paper # 12) A recombinant nucleic acid comprising a coding strand encoding a polypeptide comprising SEQ ID NO:2, 4, 6, 8, or 10, or a subsequence thereof having at least 12 consecutive residues thereof, wherein said subsequence is contained in neither residues 168-217 of SEQ ID NO:8, nor residues 1316-1520 of SEQ ID NO:8, nor SEQ ID NO:12, wherein said strand is flanked by fewer than 500 bp of flanking sequence.

Claim 68 (Paper # 21) (Replaced claim 10.) An isolated polypeptide comprising a coding strand encoding a polypeptide comprising a sequence of at least 12 consecutive residues of SEQ ID NO:2.

As can be seen the elected claim was significantly amended after the first Office action on the merits. The latest amendment to the claims divided claim 10 into a number of independent claims each specific to a single SEQ ID NO. None of the amendments have resulted, however, in meeting the requirements of 35 U.S.C. 112, first paragraph for reasons set forth in each Office action.

A review of the course of prosecution shows that the third Office action (the first Office action being a restriction requirement only) was made Final. Thereafter the application was transferred to a new examiner as the previous examiner had left the Office. Upon review of the pending claims it was determined that certain prior art anticipated some of the claims and that prosecution would necessarily be reopened. Therefor a new Office action presenting new rejections over prior art, but maintaining the rejections over 35 U.S.C. 112, first paragraph, was mailed to applicants. Since then the Office actions have not been made Final due to the necessity of applying new art in response to applicants amendments or due to the issuance of new guidelines with respect to 35 U.S.C. 101 questions.

As noted in the statute, 35 U.S.C. 132 entitles an applicant to at least one reexamination of an application, but does not preclude multiple reexaminations. The Office, however, is precluded from issuing an application as a patent unless it appears that under the law an applicant has satisfied all the requirements of the law. While it is the desire of the Office to conclude examination as quickly as possible it is not always possible to do so due to the issues involved, changes in procedures and/or rules, the nature and extent of amendments by applicants and discovery or issuance of new prior art applicable to the claims. While examination of an application is normally brought to conclusion in approximately three Office actions, there is no requirement that it must be concluded in any set number of Office actions. M.P.E.P. 707.02 requires supervisory examiners to be aware of applications pending for more than five years or in which three or more actions have been taken with a view to finally concluding prosecution. (Signing of the examiner's Office action by the SPE to indicate such review, however, is not required.) The Office is as interested in concluding prosecution of an application to the satisfaction of the public and the inventor as quickly as possible and it is this heavy burden that each examiner bears in the prosecution of any application.

In addition to the above, it is noted that the examiner has generally rejected all of the pending claims under 35 U.S.C. 112, first paragraph as lacking written description in the specification (or its parent) or lacking enablement in the specification (or its parent) and under 35 U.S.C. 132 and

112 as containing new matter. The examiner has pointed out the reasons why the claims are not enabled or described in the manner necessary to convey to one of skill in the art that applicants had possession of the invention at the time of filing of the application.

Applicants' petition is **DENIED**.

Applicants are reminded of the requirement to reply to the last Office action (mailed March 27, 2001) within the time period set or as extended under 37 CFR 1.136(a).

Any request for reconsideration of this decision must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely. No extension of time under 37 CFR 1.136(a) will be permitted.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

Jasemine C. Chambers
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